

REMARKS

Claims 1-14 are pending in the above-identified application. Claim 1 has been amended. Support for the recitations in claim 1 can be found in the examples of the present specification. Thus, no new matter has been added. Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Examiner's Interview

Applicants would like to thank the Examiner for her time during the interview on February 2, 2010. Applicants appreciate the courtesies extended to them in this application. Based on the discussions during the interview, Applicants believe that the claims are now in condition for allowance. Should the Examiner believe that there remains any outstanding issues, Applicants respectfully request that the Examiner contact Applicants' Representative so as to expedite resolution of these outstanding issues, via an Examiner's Amendment or the like.

Issues under 35 U.S.C. § 112, second paragraph

Claims 1-14 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the Examiner asserts that the phrase "plant growth promoting amount" in claims 1 and 6 is unclear. Applicants respectfully traverse.

During the interview, the Examiner indicated that this rejection would be withdrawn. Applicants respectfully request that the Examiner do so.

Issues under 35 U.S.C. § 102(b)

Claims 1-2 and 5 are rejected under 35 U.S.C. § 102(b) as being anticipated by Eicken et al. '745 (US 6,143,745). Applicants respectfully traverse. Reconsideration and withdrawal of this rejection are respectfully requested based on the following considerations.

Legal Standard for Determining Anticipation

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art.” *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Distinctions over the Cited References

Eicken et al. ‘745 disclose the fungicidal use of a composition containing at least one amide compound and, mandatorily, a further component of pyridaben, fenpyroximate, or tebufenpyrad (abstract).

In stark contrast, independent claim 1 recites that a “growth regulator consists essentially of: (1) an amide compound having the formula I...and, optionally, (2) a strobilurin” (emphasis added). Eicken et al. ‘745 do not disclose a composition that consists essentially of an amide compound having the formula I and an optional strobilurin. The phrase “consists essentially of” limits the scope of a claim to the specified materials and those that do not materially affect the basic and novel characteristics of the claimed invention. Applicants respectfully submit that the cited references disclose additional materials that would materially affect the basic and novel characteristics of the present invention. Eicken et al. ‘745 state, “It is an object of the present invention to make available an improved possibility of controlling harmful fungi and in particular Botrytis. Surprisingly, we have found that this object is achieved by a composition which as active compounds contains the substances pyridaben..., fenpyroximate...or tebufenpyrad...known as acaricides and amide compounds of the following formula I” (col. 2,

lines 18-27). Thus, Eicken et al. '745 never disclose a composition without pyridaben, fenpyroximate, or tebufenpyrad, and in fact, these compounds have a material effect on the composition of Eicken et al. '745.

Accordingly, the present invention is not anticipated by Eicken et al. '745 since the reference does not teach or provide for each of the limitations recited in the pending claims.

Issues under 35 U.S.C. § 103(a)

- 1) Claims 1-11 and 14 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Eicken et al. '745 (US 6,143,745).
- 2) Claims 12-13 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Eicken et al. '745 in view of Asrar et al. '371 (US 2003/0060371).

Applicants respectfully traverse. Reconsideration and withdrawal of these rejections are respectfully requested based on the following considerations.

Legal Standard for Determining Prima Facie Obviousness

MPEP 2141 sets forth the guidelines in determining obviousness. First, the Examiner has to take into account the factual inquiries set forth in *Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), which has provided the controlling framework for an obviousness analysis. The four *Graham* factors are:

- (a) determining the scope and content of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue;
- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating any evidence of secondary considerations.

Graham v. John Deere, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966).

Second, the Examiner has to provide some rationale for determining obviousness. MPEP 2143 sets forth some rationales that were established in the recent decision of *KSR International Co. v Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007).

As the MPEP directs, all claim limitations must be considered in view of the cited prior art in order to establish a *prima facie* case of obviousness. See MPEP 2143.03.

Distinctions over the Cited References

As discussed above, Eicken et al. '745 do not disclose each and every aspect of the pending claims. Regarding the second rejection under 35 U.S.C. § 103, Applicants respectfully submit that Asrar et al. '371 do not overcome the deficiencies of this reference.

To establish a *prima facie* case of obviousness of a claimed invention, all of the claim limitations must be disclosed by the cited references. As discussed above, Eicken et al. '745 with or without Asrar et al. '371 fail to disclose all of the claim limitations of independent claim 1, and those claims dependent thereon. Accordingly, the combination of references does not render the present invention obvious.

Furthermore, the cited references or the knowledge in the art provide no reason or rationale that would allow one of ordinary skill in the art to arrive at the present invention as claimed. Therefore, a *prima facie* case of obviousness has not been established, and withdrawal of the outstanding rejections is respectfully requested. Any contentions of the USPTO to the contrary must be reconsidered at present.

CONCLUSION

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case clearly indicating that each of claims 1-14 are allowed and patentable under the provisions of title 35 of the United States Code.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Chad M. Rink, Reg. No. 58,258 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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